THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RONALD L. LIPP

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Appeal No. 97-1504
Application No. 08/400,190[1]

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-5 and 7-28, which constitute all of

[1] Application for patent filed March 6, 1995. According to appellant, this application is a continuation of application 08/007,873 filed January 22, 1993, now abandoned.

the claims remaining of record in the application, claim 6 having been canceled.

The appellant's invention is directed to a method for displaying messages which have been stored in the memory of a pager. The subject matter before us on appeal is illustrated by reference to claims 1 and 27, which have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Levine	4,336,524	Jun. 22, 1982
Tsunoda et al. (Tsunoda)	4,536,761	Aug. 20, 1985
Wagai et al. (Wagai)	5,285,493	Feb. 8, 1994 (filed June 25, 1991)
Lipp	5,398,022	Mar. 14, 1995

THE REJECTIONS

Claims 1-3, 7, 8, 12-15, 19-21, 25 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wagai in view of Levine.

Claims 4, 5, 9-11, 16-18 and 22-24 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent No. 5,398,022 in view of Wagai and Levine.

Claims 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wagai in view of Tsunoda.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

All three of the examiner’s rejections are grounded in obviousness. This means that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The appellant's invention is directed to pagers that are capable of storing and displaying multiple messages. The objective of the invention is to provide alternative methods for displaying the stored messages or pages of messages, which includes sequentially viewing the multiple messages or pages by scrolling through them, or by viewing them individually. In furtherance of this, the claims recite various methods, all of which involve the operation of a multiple function switch in which the application of a single input to the switch initiates a mode wherein the stored messages (or pages of messages) are sequentially displayed in a free-running display automatically carried out without further input signal from the switch, and wherein the input of a subsequent signal to the switch causes the cessation of the free-running mode in favor of a manual mode in which messages (or pages) are presented one at a time.

With regard to independent claims 1, 12 and 21 (messages with more than one page), and 7 and 15 (messages), the examiner has taken the position that the subject matter recited would have been obvious to one of ordinary skill in the art in view of the teachings of Wagai and Levine.

The thrust of the Wagai invention is to improve upon the prior art situation in which the display switch has to be operated many times in order to display a plurality of stored messages (column 2, line 9 *et seq.*). To overcome this problem, Wagai teaches displaying stored messages either sequentially by scrolling through them or manually, one at a time. According to the Wagai method, stored messages are sequentially presented in a scrolling manner so long as the user depresses (activates) and holds switch 11. When the switch is released, the scrolling stops and a single message is displayed. Another message is manually displayed if switch 11 is momentarily activated. See column 7, line 26 *et seq.* This is essentially the opposite of the method recited in the appellant's claims. Wagai does not disclose or teach a method wherein a free-running display of stored messages is initiated by the receipt of a user input signal to a multiple function switch without further receipt of a user input signal, and wherein said free-running display is terminated and a manual display mode initiated upon receipt of a subsequent user input signal. In other words, wherein the appellant's invention is

a method in which scrolling is started by a short duration activation of a multifunction switch and continues until another short duration activation of that switch is made, Wagai starts the scrolling by activating and holding the multifunction switch in the activated position, and stops it by releasing the switch.

The examiner deals with the above-noted insufficiency in Wagai in three ways. First, the examiner asserts that the claimed method would have been obvious "because Wagai et al. et al. [*sic*] suggests manual, or sequential and automatic free-running displaying of the messages, or both with the activation of a switch" (Answer, page 4). However, the issue is whether Wagai teaches the method of recited in the claims, in which certain manners of operating a single switch result in a particular modes of message display. The fact is that while the methods of both the appellant's invention and Wagai utilize a single switch to initiate two different modes of message display, they do not accomplish this by the same steps. The second assertion by the examiner has to do with switching "typically used in automatically programming VCR's" (Answer, page 4). Even if we were able to fully understand

this discussion, it fails because it is merely the examiner's opinion, unsupported by evidence.

The third of the examiner's theories is that Levine discloses an auto scroll switch, with regard to which "[t]here is no indication that it is necessary for switch (59) to be continuously actuated" (Answer, page 5). Levine's explanation of the manner in which switch 59 affects the operation of the pager message display system is not crystal clear. However, even assuming, *arguendo*, that the examiner's conclusion is correct, to modify the Wagai method in the manner proposed by the examiner would destroy the method espoused by Wagai as the inventive solution to the problem, which in our view would operate as a disincentive to the artisan. Moreover, we fail to perceive any suggestion in either of the references which would have motivated one of ordinary skill to make such a wholesale change in the Wagai method, except the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is impermissible. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our conclusion that the combined teachings of Wagai and Levine fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claims 1, 7, 12, 15 and 21 and, it follows, of dependent claims 2, 3, 8, 13-15, 19, 20, 25 and 26.

Dependent claims 4, 5, 9-11, 16-18 and 22-24 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,398,022, taken in view of Wagai and Levine. According to the examiner, "the appellant has already received a patent for the limitations of claims 4, 5, 9, 10, 16, 17, 22, and 23 in claims 1-19 of . . . [the patent]" and "to include the steps of claims 1-3, 7-8, 12-15, and 18-21, in the method of the claimed invention of . . . [the patent] would have been obvious to one of ordinary skill in the art" in view of Wagai and Levine because they "suggest such method limitations are known in the art" (Answer, paragraph bridging pages 5 and 6).

The referenced patent claims are directed to a method of actuating a switch to illuminate the display of a pager and to cause other functions to take place concurrently, and thus

they clearly do not themselves encompass the method recited in the claims before us, which deals with the presentations of displays. The teachings of Wagai and Levine have been set forth above, as have their deficiencies with regard to the appellant's independent claims. The examiner has not explained what "limitations" in the patent claims form the basis for the rejection, what teachings of Wagai and Levine are relied upon, and how the references would be combined. From our perspective, therefore, a *prima facie* case of obviousness-type double patenting has not been established, and we will not sustain this rejection.

Independent claim 27 stands rejected as being unpatentable over Wagai in view of Tsunoda. This claim requires that the pages be transferred sequentially to the display of the pager "in response to a single short-duration actuation of a multiple function switch," and hold a displayed page "in response to a second discrete actuation of said multiple function switch." As we explained above, this teaching is not present in Wagai. The examiner states that Tsunoda teaches "holding a display of a paged message for so long as the switch is actuated," and then concludes that "[i]t

would have been obvious . . . to maintain the display of the paged message so long as the switch is in the actuated state in the pager of Wagai . . . because Wagai et al. suggests displaying a paged message upon actuation of a switch and Tsunoda et al. teaches the message is displayed until deacctuation [sic] of the switch" (Answer, page 6).

Again, we find ourselves struggling to understand the rejection. It is true that Wagai teaches displaying a paged message upon actuation of a switch. However, that display lasts only as long as the switch is held in the actuated position, and ceases when it is released which, according to the examiner, is exactly what Tsunoda teaches. Thus, Tsunoda would seem to add nothing to the teachings of the primary reference. It is our view that a *prima facie* case of obviousness is not established by the combined teachings of these two references, and therefore we will not sustain this rejection.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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Sidley & Austin
717 North Harwood
Suite 3400
Dallas, TX 75201